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| 10/751,475 | 01/06/2004 | Haruo Inoue | 8012-1221 | 2336 |
| 466 7590 10/14/2008 YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314 | | | EXAMINER KIM, ANDREW | |
| | | | ART UNIT 3714 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/751,475

Applicant(s)

INOUE, HARUO

Examiner

ANDREW KIM

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3, 5-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 06 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This office action is in response to the amendment filed on 6/27/08 in which:

- Response to claims rejection have been filed.
- Claim(s) 1-3, 5-20 are pending.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 13 of U.S. Patent No. 6,905,408. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the two sets of claims is

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that the instant application claims rotating a reel in normal and reverse direction which is covered by the claims and specification of the '408 patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3 and 5-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (US 5,395,111) in view of Dickenson et al. (US 5251898 A) and further in view of Mineno (JP 2003-230693).

Inoue discloses a slot machine with double reels wherein the outer reel is transparent and composite symbols are formed utilizing both reels.

Dickenson discloses a slot machine in which the reels can move backward and forward.

Claims 1, 11, 14. Inoue discloses a symbol display device, for a game machine, that determines win or loss of a game according to symbol combinations displayed in a display window, said symbol display device comprising:

plural reel units rotatably aligned in a row behind said display window, each of said plural reel unit being provided with symbols, at least one of said plural reel units being double reels including an inner reel and a transparent outer reel (abstract);

a first symbol provided on said outer reel, said first symbol forms a composite symbol by overlaying said first symbol on a second symbol provided on said inner reel (col. 4:55 – 5:44); and

a controller for controlling rotation of said plural reel units, said controller controls said inner reel to stop after rotating in a normal direction and controls said outer reel to stop after rotating in said normal direction and a reverse direction repeatedly for each game and only within a range that said first symbol is displayed in said display window before win or loss of said game is determined (col. 4:55 – 5:44).

Inoue substantially discloses the invention as claimed but fails to explicitly teach the outer reel rotating in a normal and reverse direction. Instead, Inoue discloses the reels rotating in a forward direction. However, in an analogous reference, Dickenson teaches reels that move in the forward and reverse directions (Dickenson, abstract and col. 1) to increase player appeal. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to modify Inoue with Dickenson's reverse rotating reels to increase player appeal.

Inoue substantially discloses the invention as claimed but fails to explicitly teach that rotating the plural reel units in a normal and reverse direction repeatedly for each game and only within a range that the first symbol is displayed. Instead, Inoue discloses the reels rotating in a forward direction. However, in an analogous reference, Mineno discloses in paragraph 37-44 rotating plural reel units in a normal and reverse direction repeatedly for each game and only within a range that the first symbol is displayed to present information pertaining to special profits to players by using drums for an image display device and increasing player appeal. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to modify Inoue with Mineno to increase player appeal.

Claim 2. Inoue discloses wherein said first reel stops the rotation after said second reel stops the rotation (col. 6:1-15).

Claim 3. Inoue discloses wherein said winning symbol is provided in the second reel (col. 4:55 – 5:44).

Claims 5, 16. Inoue discloses further comprising: a decoration symbol, said decoration symbol provided in the first reel; wherein said controller rotates the first reel to overlay said decoration symbol on said symbol related to win in the second reel after said win is decided (col. 4:55 – 5:44). The decoration symbol has been interpreted as any symbol that overlays another symbol.

Claims 6, 17. Inoue discloses wherein said decoration symbol is not displayed in said display window while the first reel repeats the rotation in said normal and said reverse directions. This is inherently present because while any reel is in rotation, no specific symbol is displayed to the player.

Claims 7, 18. Inoue discloses further comprising: a shielding symbol provided in said outer reel, said shielding symbol shields a part of a symbol provided in said inner reel (col. 4:55 – 5:44, fig. 6). A shielding symbol has been interpreted as any symbol that overlays another symbol.

Claim 8. Inoue discloses wherein said shielding symbol is not displayed in said display window while the first reel repeats the rotation in said normal and said reverse directions. This is inherently present because while any reel is in rotation, no specific symbol is displayed to the player.

Claims 9, 12, 19. Inoue discloses wherein plural zones are provided in outer periphery of said first reel; wherein said controller controls the rotation of said first reel such that only one of said plural zones is displayed through said display window, and changes a zone to be displayed in said display window according to a game stage (col. 4:55 – 5:44, fig. 6). A zone has been interpreted as a symbol and the empty space around the symbol.

Claims 10, 13, 20. Inoue discloses wherein one of said plural zones is a win/loss determining zone consisting essentially of said winning symbol and non-symbol area; wherein said controller rotates said first reel in said normal and said reverse directions in a range that only said win/loss determining zone is displayed in said display window (col. 4:55 – 5:44, fig. 6).

Claim 15. Inoue discloses wherein said controller controls rotation of the second reel to stop after rotating in said normal and said reverse directions repeatedly within a range that said winning symbol is displayed in the display window (col. 4:55 – 5:44).

Response to Arguments

Applicant's arguments filed 6/27/08 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Regarding the double patenting, refer to 3:30-46 of the '408 patent. The outer reel symbol is displayed while inner reel is rotated.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ANDREW KIM** whose telephone number is (571)272-1691. The examiner can normally be reached on **M-F**.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on **571-272-7147**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Supervisory Patent Examiner, Art Unit 3714

10/15/2008 /A. K./
Examiner, Art Unit 3714



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TC3700